



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,906	01/09/2002	Greta Arnaut	58764.000036	1498

21967 7590 10/03/2006

HUNTON & WILLIAMS LLP
INTELLECTUAL PROPERTY DEPARTMENT
1900 K STREET, N.W.
SUITE 1200
WASHINGTON, DC 20006-1109

EXAMINER

KUBELIK, ANNE R

ART UNIT	PAPER NUMBER
----------	--------------

1638

DATE MAILED: 10/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

10/040,906

Applicant(s)

ARNAUT ET AL.

Examiner

Anne R. Kubelik

Art Unit

1638

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 11 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☒ The Notice of Appeal was filed on 11 September 2006. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: 57,63-69,71,74,76,77,79 and 81.
Claim(s) objected to: _____.
Claim(s) rejected: 85-86.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

Continuation of 5. Applicant's reply has overcome the following rejection(s):

102(e); 103(a) of claims 58, 77 and 80 over '293 in view of Audtho and further in view of Schenpf; 103(a) of claims 71 and 76 over '293 in view of Audtho and further in view of Schenpf and further in view of '711, '542 and '608: .

Continuation of 11. does NOT place the application in condition for allowance because:

103(a) of claims 85-86 over '293 in view of Audtho and further in view of Schenpf and further in view of '711, '542 and '608:

Applicant urges that '293 fails to disclose N-terminally truncated SEQ ID NO:2. This is not found persuasive because the rejection stated that '293 discloses SEQ ID NO:2, not that it disclosed N-terminally truncated SEQ ID NO:2.

Applicant urges that '293 provides no motivation to combine with any other reference. This is not found persuasive because the motivation comes from the other references.

Applicant urges that Audtho is primarily concerned with the serial digestion is Cry2A1, not with the production of a chimeric gene comprising truncated SEQ ID NO:2; Cry2Aa1 has a unique mode of action among Cry proteins. This is not found persuasive. CryAa1 was being compared to Cry1 and Cry3 proteins, not to other Cry2 proteins. Audtho showed that the proteins itself is activated by N-terminal truncation; one of skill in the art would thus have motivation to express truncated proteins because these truncated proteins would be activated upon expression, without needing truncation within the insect gut.

Applicant urges that Schnepf is directed to proteins other than SEQ ID NO:2, and the truncation statement is directed to Cry1A proteins, citing 4 exhibits.

This is not found persuasive because there is no mention that the proteins are Cry1A and that it wouldn't work with other Cry proteins. The exhibits will not be considered because Applicant fails to provide a showing of good and sufficient reasons why the evidence was necessary and not presented earlier.

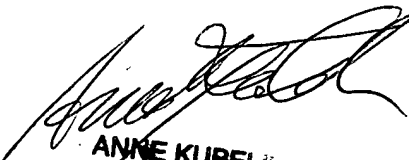
Applicant urges that the truncated proteins in Schnepf resulted in comparatively low expression, thus not providing motivation to combine; Schnepf instead focuses on other strategies to avoid insect resistance. This is not found persuasive because Schnepf states that expression was improved over non-truncated (pg 793); improved expression is also motivation.

Applicant urges that '771 is not drawn to SEQ ID NO:2, and the focus of the patent was on the promoters not dependent upon RNA Pol III. '711 is withdrawn from the rejection due to Applicant's amendment of claim 71.

Applicant urges that '542 does not disclose SEQ ID NO:2 and showed that adding a transit peptide resulted in abnormal phenotypes and decreased expression. This is not found persuasive because the superior expression with the Cry2Ab protein provides motivation to combine.

Applicant urges that '608 does not disclose SEQ ID NO:2 and is concerned with a specific Cry1Ab gene. This is not found persuasive because '608 teaches the use of the CaMV 3 termination sequence in expression of a Cry protein.

In response to Applicant's argument that Audtho, Schnepf, '542, '771 and 608 do not teach SEQ ID NO:2, Applicant's is arguing against the references individually; one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).



ANNE KUBEL
PRIMARY EXAMINER